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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,291	04/16/2004	Catherine Helen Gebotys	1679-14/EDEV	7948

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Dimock Stratton LLP/Research In Motion Limited
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CANADA

EXAMINER

TRUONG, THANHNGA B

ART UNIT	PAPER NUMBER
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2438

NOTIFICATION DATE	DELIVERY MODE
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05/26/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/825,291	Applicant(s) GEBOTYS, CATHERINE HELEN	
	Examiner THANHNGA B. TRUONG	Art Unit 2438	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the communication filed on February 25, 2010. Claims 9-13 and 30-34 are pending. Claims 1-8, 14-29, and 35-58 are cancelled by the applicant. At this time, claims 9-13 and 30-34 are still rejected.

Response to Arguments

2. Applicant's arguments filed February 25, 2010, with respect to the rejection(s) of claim(s) 9-13 and 30-34 under 35 USC 103 have been fully considered and are persuasive.

Applicant's arguments filed February 25, 2010, with respect to the rejection(s) of claim(s) 9-13 and 30-34 under 35 USC 101 have been fully considered but they are not persuasive.

Applicant has argued that:

Claims 9 and 12 recited the language "a processing unit" that is tangible and is statutory.

Examiner respectfully disagrees with the applicant and still maintains that:

The recited language "a processing unit" appears to be only in the claim and not support elsewhere by the specification. Furthermore, in response to applicant's arguments, the recitation "a processing unit" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As to dependent claims 10-11 and 13, they are rejected under 35 U.S.C. § 101 for depending upon the non-statutory subject matter recited by independent claims 9 and 12 respectively.

As for claims 30-34, Applicant has tried to replace the term "embodied" to "stored" to overcome the 35 USC 101 rejection. However, the newly amended terminology does not really change any scope of the invention that could make claims

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30-34 become tangible. Besides, the specification of the instant application, page 10, lines 1-4 of paragraph 43, has shown the evident that "***the computer program product may be embodied in, signals carried by networks, including the Internet or may be embodied in media such as magnetic, electronic or optical storage media.***."

This evident of the specification for computer program product clearly includes carrier wave mediums and propagated data signals over a network which is nonstatutory. "Carrier waves (such as data transmission through the internet)..." is not a "process, machine, manufacture, or composition of matter."

As to dependent claims 31-32 and 34, they are rejected under 35 U.S.C. § 101 for depending upon the non-statutory subject matter recited by independent claims 30 and 33 respectively.

For the above reason, the rejection under 35 USC 101 is still maintained.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-13 and 30-34 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to independent claims 9 and 12, while the claim recites a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. § 101 must (1) be tied to a particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. *See page 10 of In Re Bilski 88 USPQ2d 1385.* Specifically, claim 9 recites "a split-mask, masking countermeasure method for improving the resistance, to power analysis attacks, of a processing unit performing a defined cryptographic function using a key, the method comprising the following steps: obtaining the key and a random key mask value r ... to define input for the masked function", but nowhere in the claim does it state what particular apparatus does (or is positively tied with) these series of steps. Because the instant claim is neither

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positively tied to a particular machine that accomplishes the claimed method steps nor transforms underlying subject matter of the claim to a different state or thing, the claim therefore does not qualify as a statutory process under 35 U.S.C. § 101.

As to dependent claims 10-11 and 13, they are rejected under 35 U.S.C. § 101 for depending upon the non-statutory subject matter recited by independent claims 9 and 12 respectively.

As to independent claim 30 and 33, these claims recite "the computing device program product for improving the resistance... ", however in the specification, page 10, lines 1-4 of paragraph 43, Applicant has defined computer program product as "***the computer program product may be embodied in, signals carried by networks, including the Internet or may be embodied in media such as magnetic, electronic or optical storage media.***." This definition of computer program product clearly includes carrier wave mediums and propagated data signals over a network which is nonstatutory. "Carrier waves (such as data transmission through the internet)..." is not a "process, machine, manufacture, or composition of matter." Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a carrier wave cannot be patentable subject matter." (In re Petrus A.C.M. Nuijten; Fed Cir, 2006-1371, 9/20/2007). Because the full scope of claims 30 and 33 as properly read in light of the disclosure encompasses non-statutory subject matter (i.e., because the limitation "computer program product" would include a non-statutory signal, carrier wave, etc.), claims 30 and 33 are rejected under 35 U.S.C. § 101 for reciting non-statutory subject matter.

As to dependent claims 31-32 and 34, they are rejected under 35 U.S.C. § 101 for depending upon the non-statutory subject matter recited by independent claims 30 and 33 respectively.

Conclusion

5. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached at 571-272-3787. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/
Primary Examiner, Art Unit 2438

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TBT

May 8, 2010